

REMARKS

Applicant respectfully requests reconsideration of this application, as amended herein. Claims 1-16 were pending in the application. In this amendment, Claims 2 and 11 have been canceled, Claims 1, 5, 7-9, and 12-15 have been amended, and new claims 17-22 have been added. Therefore, Claims 1, 3-10, and 12-22 are pending in the application.

The Rejections under 35 U.S.C. § 102

The Examiner has rejected Claims 1 and 2 under 35 U.S.C. 102, as being anticipated by Blum et al. (US5918223). Applicant respectfully traverses the rejections. As Claim 2 has been canceled and its limitations incorporated into Claim 1, Applicant submits that the rejection is now moot with regard to Claim 2.

Fundamentally, Blum et al. do not teach a method of analyzing music, they teach a method of analyzing a sound. Indeed, Blum et al. specifically states that the methodology that the Examiner cites as disclosing the present invention is not applicable to music (column 22, lines 31-33). Accordingly, Blum et al. do not perform analysis of musical rhythm, octave, and noise as required by the present invention. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *M.P.E.P.* 2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Furthermore, a Claim is anticipated by a reference if that reference discloses all the non-inherent elements of that Claim. *M.P.E.P.* § 2131. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). Blum et al. do not teach all the characteristics for analyzing music because not all the physical parameters of music are included in mere sounds. While Blum et al. disclose a method for analyzing music, the methodology uses a decision tree, which is quite different and clearly not the methodology described and claimed in the present invention.

The Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US5918223) in view of U.S. Patent Application Publication No. 2004/0039913 by Kruse. Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation, either in the references themselves or in a convincing line of reasoning with knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See Manual of Patent Examining Procedure (MPEP) §2144; *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). There is no suggestion to combine the references. Furthermore, since, as described above, the Blum et al. reference teaches away from the analysis methodology for music; it does not make sense to modify the Blum et al. teachings as described by the Kruse application.

The Examiner has rejected Claims 4-8 under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US5918223) in view of U.S. Patent Application Publication No. 2003/0045953 by Weare. Applicant respectfully traverses the rejections.

With regard to claim 4, the Examiner has selected a single portion from a reference to arrive at the present invention. Neither of the references supplies the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

With regard to claims 5-8, Blum et al. do not teach the methodology as described to select a representative portion of the music file by dividing the file into portions, creating a portion vector for each portion, comparing the portion vector to the song vector, and then selecting and storing one of the portions that has a portion vector most closely mathematically matching the song vector.

As the Examiner is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572,

221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Examiner has selected portions from two references to arrive at the present invention, in which, neither of the references supply the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Moreover, as described above, the Blum et al. reference teaches away from the analysis methodology for music, and, even if it did, the teaching of Blum et al. does not include all elements of the claims. Therefore, Applicant submits that the combination of the Blum et al. patent and the Weare application fails to establish a 35 U.S.C. §103(a) showing of obviousness.

The Examiner has rejected Claims 9-12, 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US5918223) in view of U.S. Patent Application Publication No. 2002/0147628 by Specter et al. Applicant respectfully traverses the rejections.

As described above, the Blum et al. reference teaches away from the analysis methodology for music; it does not make sense to modify the Blum et al. teachings as described by the Specter et al. application. Furthermore, there is no teaching in Specter et al. to mathematically evaluate the music files. While Specter et al. refer to comparing a distance between items, the file analysis is described as merely subjective. Additionally, there is no motivation or suggestion to combine the teachings of Blum et al. and Specter et al.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a

whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986). With regard to Claims 15 and 16, the teachings of Specter et al. establish a database by having several customers take a consumer preference test. There is nothing to suggest that the songs have reached any threshold of commercial success. Accordingly, it is not possible, with the teachings of Specter et al., to determine the potential for commercial success for a new song.

The Examiner has rejected Claims 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Blum et al. (US5918223) in view of U.S. Patent Application Publication No. 2002/0147628 by Specter et al. and further in view of U.S. Patent Application Publication No. 2003/0045953 by Weare. Applicant respectfully traverses the rejections.

The Examiner has selected a portion from a couple of references to arrive at the present invention. None of the references supplies the motivation for the additional references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Furthermore, as described above, only the Blum et al. reference describes any mathematical analysis, but specifically does not apply itself to music files. While the remaining references address music files, neither describes the detailed mathematical analysis taught in the present invention.

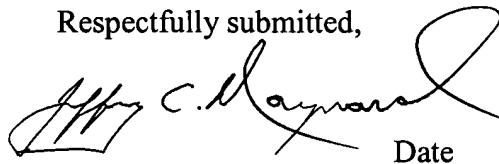
The New Claims

Applicants have added new dependent Claims 17-22 eliciting additional features of Applicants' invention. It is believed such claims are also allowable. For renumbering purposes, it is suggested that new Claims 17-19 should come immediately after Claim 5 and new Claims 20-22 should come immediately after Claim 9.

CONCLUSION

Applicant has made a diligent effort to address the rejections identified by the Examiner, and respectfully submits that the outstanding rejections in the Office Action have been overcome. In view of the above amendments and remarks, all pending claims are believed to be patentable, and thus, the case is in condition for allowance. Accordingly, a Notice of Allowability is respectfully requested at the Examiner's earliest convenience. In the event that there is any question concerning this response, or the application in general, Applicant respectfully requests that the Examiner contact Applicant's attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,

 1/23/06
Date

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